

*A*

33. (New) The computer of claim 19, wherein installing the operating system includes specifying information generated utilizing the external configuration file as the information setup file for the OS setup file.

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#### **REMARKS**

Reconsideration of the above-identified application, as amended, is respectfully requested. Previously existing claims 1-27 and new claims 28-33 are currently pending in this application. Claims 1, 10, and 19 were amended to incorporate the teachings of each of the three embodiments.

The Office Action rejected claims 1-27. More particularly, the Office Action rejected:

- Claims 1-5, 7-8, 10-14, 16-17, 19-23, and 25-26 under 35 U.S.C. § 103(a) as being obvious over *Leyda* in view of *Harding*; and
- Claims 6, 15, 24 and 9, 18, 27 were rejected under 35 U.S.C. § 103(a) as being obvious over *Leyda* in view of *Harding* and, respectively, *Lipe et al.* and “admitted prior art.”

Applicants respectfully traverse these rejections.

**A. Claims 1-5, 7-8, 10-14, 16-17, 19-23, and 25-26 Are Not Rendered Obvious By *Leyda* in Combination with *Harding***

In addition to a lack of motivation to combine which will be addressed shortly, the rejection of claims 1-5, 7-8, 10-14, 16-17, 19-23, and 25-26 as being rendered obvious by *Leyda* in view of *Harding* is insupportable in that the combination fails to teach or suggest at least one step recited in each of the application's only independent claims, 1, 10, and 19. More specifically, the Office Action admits that "Leyda does not teach installing the operating system according to information stored in the external configuration file and the particular device's identity" and contrary to the assertion otherwise, *Harding* fails to teach or suggest the same step admittedly not taught or suggested by *Leyda*. Moreover, *Harding* actually teaches away from the aforementioned step.

The office action takes the untenable position that the aforementioned step, and therefore the entire claim, was made obvious since, "Harding teaches installing the operating system according to information stored in a setup file" and also because "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Leyda with Harding because the external file for handling the device drivers can be incorporated into a program for installing an operating system and this combination would facilitate the updating of systems by allowing drivers and or the OS to be more easily and correctly changed."

This argument initially fails because *Harding* does not teach or suggest what it is asserted to teach or suggest, "installing the operating system according to information stored in a setup file." To the contrary, *Harding* says that the asserted setup file is an executable set in motion by the end user, on a computer in which all files including the operating system (OS) along and the needed hardware drivers have already been installed on the computer at the factory, wherein the

setup file simply decompresses the language-dependent OS files after the user selects the language. See *Harding*, C13L1-43 (i.e., Column 13, Lines 1-43). *Harding* simply does not contemplate the external configuration file required by the claimed invention, likely because it is not needed to update the language modules.

Next, the argument fails because *Harding* expressly teaches away from the claimed invention. Consistent with *Harding*'s express goal of minimizing setup time for the end user, C12L34, the OS and needed hardware drivers are pre-installed at the factory via image files as opposed to installed by running a setup file, C12L35-39, intentionally eliminating the possibility that the asserted setup file might install the OS according to information stored in "an external configuration file containing information about a plurality of devices that might be associated with the computer." Therefore, *Harding* is inimical to the claimed invention, which not surprisingly is why the claimed invention is neither taught nor suggested by a combination of references including *Harding*.

Accordingly, *Leyda* in combination with *Harding* does not lead one skilled in the art towards the claimed invention. Instead, the asserted combination leads one skilled in the art away from the claimed invention. Since the void left by this untenable combination is incapable of being bridged by an assertion of obviousness, let alone motivation to combine, claims 1-5, 7-8, 10-14, 16-17, 19-23, and 25-26, as amended, are allowable over *Leyda* in view of *Harding*. Similarly, in light of their dependence on independent claims 1, 10, and 19, claims 6, 9, 15, 18, 24, 27, and new claims 28-33 are allowable over any asserted combination relying on *Leyda* in view of *Harding*.

With respect to the lack of motivation to combine, the asserted motivation merely recited a result reached by an implementation of the claimed invention, "facilitate the updating of

systems and devices by allowing the drivers and or the OS to be more easily and correctly changed.” *See Office Action*, Pages 1-2. Further, the alleged motivation is eerily similar to language residing in the application, “because the external configuration file is not part of the OS installation software, it can be frequently updated or modified as new devices are released or errors are identified in the internal configuration file.” *See Application*, Page 10, Lines 14-16.

The Federal Circuit has warned against the piecemeal approach taken by the Office Action to: find references potentially covering pieces of claims, artificially combine the references, and finally patch them together with the needs, goals, and results pointed out in the application; also known as impermissible hindsight. *See In re Roufett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability.”) (citation omitted).

A simple reading of the abstracts in *Leyda* and *Harding* bring a quick end to the motivation of one skilled in the art to combine the references to wind up obviating the claimed invention. *Leyda*’s abstract recites a system which “automatically identifies and loads the appropriate software driver” for peripheral devices. *Leyda Abstract* (emphasis added). This admittedly falls short of obviating the claimed invention. Next, *Harding*’s abstract recites a method “for reducing the time needed for setting up a computer system in a user selected language version of a disk operating system by pre-installing a plurality of modules for different language versions.” *Harding Abstract* (emphasis added). Armed with *Leyda* in one hand and *Harding* in the other, one skilled in the art is hardly overcome with a desire or motivation to

combine the two and somehow reach an external configuration file separate from the OS installation software for installing the OS. Reading beyond the abstracts produces the same void of motivation to combine.

The asserted combination stands devoid of motivation to combine, in contravention of a prerequisite to an obviousness rejection based on a combination of references. Therefore, the obviousness rejection again fails and, consequently, claims 1-33, as amended, are allowable over any combination relying on *Leyda* and *Harding*.

**B. Claims 6, 15, 24 and 9, 18, 27 Are Not Rendered Obvious By *Leyda* in View of *Harding* And, Respectively, *Lipe Et Al.* And “Admitted Prior Art”**

For the reasons set forth in section A, and in light of their dependence on independent claims 1, 10, and 19, claims 6, 15, 24 and 9, 18, 27 are allowable over the assertions of obviousness based on the asserted combinations relying on *Leyda* and *Harding*.

**C. New Claims 28-33 Are Not Rendered Obvious By The Asserted References In Any Combination**

For the reasons set forth in section A, and in light of their dependence on independent claims 1, 10, and 19, claims 28-33 are allowable over the assertions of obviousness based on the asserted combinations relying on *Leyda* and *Harding*.

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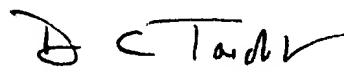
For at least the foregoing reasons, Applicant believes that claims 1-33, as amended, are in patentable condition and should be allowed, and such action is respectfully requested. More specifically, claims 1-5, 7-8, 10-14, 16-17, 19-23, and 25-26, as amended, are allowable over *Leyda* in view of *Harding*, even though it is improper to combine these references. In light of their dependence on independent claims 1, 10, and 19, claims 6, 15, 24 and 9, 18, 27 are

allowable over the asserted combinations relying on *Leyda* and *Harding*. Similarly, in light of their dependence on independent claims 1, 10, and 19, new claims 28-33 are believed to be allowable over the asserted references in any combination.

Applicant has provided payment for the addition of six dependent claims. Should the fee be deficient or absent, or in case any other fees are due, consider this paragraph such a request and authorization to withdraw the appropriate fee under 37 C.F.R. §§ 1.16 - 1.21 from Arnold White & Durkee Deposit Account No. 01-2508/MICL:024/TOE/PAC.

The Examiner is invited to contact the undersigned attorney at 713.787.1408 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

  
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